

Applicants: Robert E. Reiter, et al

Serial No.: 09/934,773

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Remarks

In its August 15, 2003 Office Action, the U.S. Patent and Trademark Office rejected the claims under 35 U.S.C. §102 (a) as allegedly anticipated by Reiter et al. (PNAS 95: 1735-40, February 1998) and under 35 U.S.C. §103(a) as obvious when taken with Vitetta et al. (*see* August 15, 2002 Office Action, Paragraphs 22 and 26).

The claims were also rejected under 35 U.S.C. §§102(a) and 103(a) in view of Reiter et al. (WO98/40403, September 1998) (*see* August 15, 2002 Office Action, Paragraphs 23 and 27).

Background

The claims of the present application were amended by the January 15, 2003 Amendment. In their January 15, 2003 Amendment, applicants addressed all of the Examiner's objections and explained that a Supplemental Amendment, with a Declaration by Dr. Reiter, under 37 C.F.R. § 1.132, would be subsequently submitted to completely address the two 35 U.S.C. § 102(a) and two 35 U.S.C. §103(a) rejections. Accordingly, applicants are submitting this Supplemental Amendment to fully address the Examiner's rejection of the claims under 35 U.S.C. §§102(a) and 103(a) in view of the two Reiter et al. references.

Upon further review of the two Reiter et al references, *i.e.*, PNAS 95: 1735-40 (February 1998) and WO98/40403 (September 1998), applicants respectfully submit that, although these two references represent applicants' own work, a Declaration under 37 C.F.R. §1.132 is unnecessary for the reasons set forth below.

Reiter et al., PNAS 95: 1735-1740 (February 1998)

The Examiner rejected claims 1, 53-63 and 87 under 35 U.S.C. §102(a) in view of Reiter et al., PNAS 95: 1735-1740 (February 1998) (*see* August 15, 2002 Office Action, Paragraph 22, page

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20). Claims 1, 53, 55, 60, 61, 63 and 87-88 were also rejected under 35 U.S.C. §103(a) over Reiter et al., in view of Vilella et al., (see August 15, 2002 Office Action, Paragraph 26).

Reiter et al., PNAS 95: 1735-1740 (February 1998), generally discloses a prostate stem cell antigen. The cited reference identifies and characterizes this cell surface antigen, but does not anticipate the claimed monoclonal antibodies.

None of the monoclonal antibodies (*i.e.*, 1G8, 2A2, 2H9, 3C5, 3E6, 3G3 and 4A10) or hybridomas (*i.e.*, HB-12612, HB-12613, HB-12614, HB-12616, HB-12618, HB-12615, or HB-12617) disclosed and recited in the claims of the present application are taught by the cited Reiter et al. reference. Accordingly, Reiter et al. does not teach or suggest the epitopes bound by the recited monoclonal antibodies. Thus, Reiter et al. does not meet the requirements of 35 U.S.C. §102(a) as anticipating the claimed subject matter or 35 U.S.C. §103(a) as suggesting the claimed subject matter.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. §§102(a) and 103(a) in view of Reiter et al., PNAS 95:1735-1740 (February 1998).

Reiter et al., WO98/40403 (September 1998)

The Examiner further rejected claims 1, 53-63 and 87 under 35 U.S.C. § 102(a) as allegedly anticipated by Reiter et al., WO98/40403 (see August 15, 2002 Office Action, Paragraph 23, Page 21). Claims 1, 53-63 and 87-88 were also rejected under 35 U.S.C. §103(a) in view of Reiter et al., WO98/40403 (see August 15, 2002 Office Action, Paragraph 27).

WO98/40403 is the published International application of the parent application of this application, namely, U.S. Serial No. 60/228,816 (formerly 08/814,279) and discloses five of the seven

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monoclonal antibodies recited in the present claims, *i.e.*, IG8 (ATCC Accession No. HB-12612), 2H9 (ATCC Accession No. HB-12614), 3C5 (ATCC Accession No. HB-12616), 4A10 (ATCC Accession No. HB-12617) and 3E6 (ATCC Accession No. HB-12618).

With respect to these five monoclonal antibodies and hybridomas recited in the present claims (and listed above), applicants perfected their claim of priority to the U.S. counterpart of the cited reference, under 35 U.S.C. §120 on March 10, 1998 in U.S. Serial No. 09/038,261, now Patent No. 6,267,960. Accordingly, the claims being rejected are entitled to the March 10, 1998 priority date and WO98/40403 is not prior art as to claims reciting these five monoclonal antibodies and hybridomas.

WO98/40403 is prior art as to the remaining two monoclonal antibodies, *i.e.*, those which recognize the epitopes of 3G3 (ATCC Accession No. HB-12615) and 2A2 (ATCC Accession No. HB-12613), but not relevant art because WO98/40403 does not disclose or suggest claims which recite these two monoclonal antibodies. Accordingly, applicants have overcome this ground of rejection and respectfully request that the rejection of the claims under 35 U.S.C. §102(a) and §103(a) in view of Reiter et al., WO98/40403 be withdrawn.

Conclusion

In view of their January 15, 2003 Amendment and the above remarks, Applicants respectfully request reconsideration and withdrawal of the rejections to the subject application.

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No fee is deemed necessary with the filing of this Supplemental Amendment. However, if a fee is deemed necessary, as stated above, authorization is hereby given to charge Deposit Account No. 50-0306.

Respectfully submitted,

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